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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,372	06/08/2001	Konrad Scholz	H 4858	2436

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EXAMINER

ROSSI, JESSICA

ART UNIT	PAPER NUMBER
1733	

DATE MAILED: 03/31/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Offic Action Summary</b>	Applicati n N .	Applicant(s)
	09/877,372	SCHOLZ, KONRAD
	Examin r	Art Unit
	Jessica L. Rossi	1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on \_\_\_\_\_.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-7 is/are pending in the application.  
 4a) Of the above claim(s) 1-4 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_. is/are allowed.  
 6) Claim(s) 5-7 is/are rejected.  
 7) Claim(s) \_\_\_\_\_. is/are objected to.  
 8) Claim(s) \_\_\_\_\_. are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_. is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 11) The proposed drawing correction filed on \_\_\_\_\_. is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.  
 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.  
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.  
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)  
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.                    6) Other:

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4, drawn to a pressure element for gluing a bandlike covering, classified in class 156, subclass 493.
  - II. Claims 5-7, drawn to a method for gluing a bandlike covering, classified in class 156, subclass 212.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the pressure element could be used to practice another and materially different process wherein the pressure element is used to glue a bandlike covering to a variety of objects not limited to a board element or profile bar thereby placing serious burden on the examiner.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. Murphy on 3/17/03 a provisional election was made with traverse to prosecute the invention of Group II, claims 5-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-4 are withdrawn

from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Finke (US 4261783).

With respect to claim 5, Finke, directed to a method for applying a label 21H (bandlike covering) to a narrow face S/S1 of a board element or profile bar having a straight or profiled cross-section (Figures 8-9) with an adhesive (column 2, lines 58-61). The reference teaches the label being pressed onto the narrow face or profile bar by means of at least one pressure element 201 that has an elastically deformable pressure face 232 matched to the shape of the narrow face or profile bar (Figure 9; column 3, lines 7-9 and 33-35; column 5, lines 15-17 and 35-39).

***Claim Rejections - 35 USC § 103***

7. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finke in view of Paulk et al. (US 6529799).

With respect to claim 5, the examiner interpreted the Finke reference to mean that the objects having surfaces S/S1 in Figures 8-9 were a board element or a profile bar as set forth in the 102 rejection above. It is noted that the reference does not limit the objects to any particular object.

It is known in the art to attach adhesive labels to boards in the center or at a corner of the board, as taught by Paulk (column 4, lines 1-5; column 6, lines 1-5; column 7, lines 57-63). If it is not taken that the object of Finke is a board element, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the label to a board element because such is known in the art, as taught by Paulk, and this allows for identification of the board element based on the information printed on the label.

As for the object being a profile bar, the skilled artisan would have appreciated that a profile bar is just an object having a rectangular cross-section, which is clearly depicted in Figure 9 of Finke.

Regarding claim 7, Paulk teaches the board element comprising chipboard, fiber board, or solid wood (column 4, lines 1-5).

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Finke, or alternatively, Finke in view of Paulk et al. as applied to claim 5 above, and further in view of Schut et al. (US 6376058).

Regarding claim 6, Finke teaches the label having a pressure sensitive adhesive that is exposed once a release layer 22H is removed (column 3, lines 58-60; column 4, lines 15-18). It is known in the art to attach labels to objects using a hot-melt adhesive as an alternative to a pressure sensitive adhesive thereby eliminating the need for a release layer, as taught by Schut (column 14, lines 9-15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a hot-melt adhesive as an alternative to the pressure-sensitive adhesive of Finke because such is known in the art, as taught by Schut, and this eliminates the need for a release layer.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **703-305-5419**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on 703-308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Jessica L. Rossi  
Patent Examiner  
Art Unit 1733

jlr  
March 24, 2003

*mwb*  
Michael W. Ball  
Supervisory Patent Examiner  
Technology Center 1700